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No. 21,068

United States Court of Appeals
For the Ninth Circuit

ILLINOIS TOOL WORKS, INC.,

Appellant,

vs.

REX L. BRUNSING, et al.,

Appellees.

APPELLANT'S PETITION FOR REHEARING

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FILED

FEB 2 1968

WM. B. LUCK, CLERK

FEB 8 1968

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*To the Honorable Frederick G. Hamley, Oliver D. Hamlin
and Ben C. Duniway, Circuit Judges:*

Most respectfully, we petition this Court to grant a rehearing of its decision filed on January 5, 1968. In finding non-infringement by limiting patent claims to specific structure "in the light of the specifications and drawings," (Slip Opinion, p. 2), the opinion creates such confusion and conflict in the law governing the interpretation of patent claims vis-a-vis the definition of infringement that rehearing and reargument are necessary—if uniformity of the law is to prevail in this circuit. In this petition, we make three points.

First. The Court will recall that, at the oral argument of this case held on April 14, 1967, we demonstrated word for word, and element for element, correspondence be-

tween the accused carrier and at least one of the claims of the Holmberg patent and argued, as noted by the Court, "that the accused structure either reads on the patent claims or is substantially equivalent thereto." (Slip Opinion, p. 2). The opinion does not find non-infringement because Brunsing omitted or avoided anything which is defined in any of the claims of the two patents. Instead, the opinion finds non-infringement solely on the basis of features of the accused device which were added to the basic structures recited in the specific words of the patent claims. By these added features, the accused carrier, in the words of the opinion, "not only obtains improved results, but it obtains those results in a substantially different manner without using the teaching of Holmberg or Poupitch." (Slip Opinion, p. 3).

This then means that the present opinion authorizes trespass upon claimed subject matter provided the putative infringer adds something which obtains an improved result not taught by the specification or drawings of the patent in suit. In announcing and applying such a principle the present opinion, we submit most respectfully, is in direct and irreconcilable conflict with

Neff Instrument Corporation v. Cohu Electronics, Inc., 298 F.2d 82, particularly pages 88-89 (decided by Judges Barnes, Hanley and Duniway on December 11, 1961, in an opinion written by Judge Barnes);

Locklin v. Switzer Brothers, Inc., 299 F.2d 160, particularly page 168 (decided by Judges Barnes, Jertberg and Merrill on November 16, 1961, in an opinion written by Judge Merrill); and

Hansen v. Colliver, 282 F.2d 66, particularly page 69 (decided by Judges Chambers, Jertberg and Koelsch on August 23, 1960, in an opinion written by Judge Jertberg).

It is also, we submit, in conflict with *Temco Co. v. Apco Co.* (1928), 275 U.S. 319, 328, where the improvement was of sufficient consequence to be patentable over the patent in suit.

Second. In deciding the legal principles governing the present claim interpretation on the basis of *Del Francia v. Stanthony Corporation*, 278 F.2d 745, (decided by Judges Barnes, Hamley and Jertberg on May 2, 1960, in an opinion written by Judge Jertberg), this Court did not have the benefit of argument on the original hearing. None of the parties cited *Del Francia* on the decided proposition. We cited *Del Francia* only for the proposition that the question of infringement resolves itself into one of law (page 35 of our opening brief). Appellees' brief and our reply brief do not even mention *Del Francia*.

Reargument should therefore be granted to permit us to point out that *Del Francia* involved the special situation of the construction of a functional or means clause under U. S. Code, Title 35, Section 112; that in *Del Francia*, "the accused device does not read word for word on the claim in the patent." (278 F.2d at p. 749); and that *Del Francia* was not intended to announce a rule of general application, as is evidenced by the later decided cases cited under point *First* of this petition for rehearing. *Neff*, *Locklin* and *Hansen* of necessity either require

a limited application of *Del Francia* to the facts of that case or by implication overrule the authority of *Del Francia*.

Third. The present opinion seems to overrule *sub silentio* at least three opinions written by different panels of this same Court. *Neff*, *Locklin* and *Hansen* were all before this Court on our opening brief. *Neff* and *Hansen* were specifically cited to the proposition which all three cases support. By implication, the present opinion might be thought to overrule the cited proposition under the authority of *Bingham v. United States* (1935), 296 U.S. 211, official headnote 4, discussed at pages 218-219.

For uniformity of decision in this circuit on this important rule of law governing the construction of patent claims, and to resolve the question of whether *Neff*, *Locklin* and *Hansen* still state the law of this circuit on the question of infringement, we suggest rehearing *en banc*. Judges Chambers, Barnes, Merrill and Koelsch, who participated in *Neff*, *Locklin* and *Hansen*, should have the opportunity to participate in any decision which undermines, or seems to undermine, the rules which those three cases establish and apply. Judges Browning, Ely and Carter, who participated in none of the cases, should have the opportunity to express their views on the conflict of opinion. If this is not done, then patentees and putative infringers alike cannot possibly know whether infringement is to be determined in this circuit by a broad and general application of *Del Francia*, as was done in the present case, or by the application of those literal interpretation principles which support the contrary decisions in *Neff*, *Locklin* and *Hansen*.

Precedent for resolving *en banc* the standards to be applied in deciding patent issues (there validity) is found in *Armour & Co. v. Wilson & Co.* (7 Cir. 1960), 274 F.2d 143, 151.

For the reasons stated, we submit most respectfully that this petition for rehearing should be granted and suggest that reargument should be heard *en banc*.

Respectfully submitted,

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CERTIFICATION

I certify that the foregoing petition, in my judgment, is well founded, and that the same is not interposed for delay.

CARL HOPPE,

Attorney for Appellant.

